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In re Application of	:	DECISION ON
GOLICZ et al	:	
Application No.: 08/962,077	:	PETITION UNDER
Filing Date: 14 September 1998	:	
Attorney Docket No.: 9534	:	37 CFR 1.137(b)
For: SHEET FEEDING APPARATUS	:	

This decision is in response to the petition entitled "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed 04 January 2001.

BACKGROUND

On 01 April 1997, applicants filed international application No. PCT/US97/05320, which claims a priority date of 01 April 1996 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 09 October 1997. The twenty-month deadline for entry into the national stage in the U.S. expired as of midnight of 01 December 1997.

On 31 October 1997, applicants filed in the United States Patent and Trademark Office, *inter alia*, a cover letter, a declaration and power of attorney, a small entity statement, a preliminary amendment, 8 sheets of formal drawings, and a check for \$527. The cover letter states that "[t]his application is a continuation of [PCT/US97/05320]."

On 14 July 1998, the PTO mailed a NOTICE OF INCOMPLETE APPLICATION (Form PTO-1123) indicating that a filing date had not been assigned because the specification was missing.

On 14 September 1998, applicants submitted a TRANSMITTAL OF SPECIFICATION which was accompanied by the entire PCT application for PCT No. PCT/US97/05320. This TRANSMITTAL stated that this "same document was previously transmitted to the USPTO as designated office on behalf of the International Bureau of WIPO".

On 14 September 1998, applicants filed a PETITION RELATING TO FILING DATE pursuant to 37 CFR 1.181. The petition requested that: (1) the above mentioned application be

granted a filing date of 31 October 1997 because the application was complete at that time "within the meaning of 35 U.S.C. 371"; (2) the above mentioned application be granted an effective filing date of 01 April 1997 under PCT Article 11(3), 35 U.S.C. 371, and 37 CFR 1.53(f); and (3) a refund of the petition fee because the application was complete as of 31 October 1997. The petition states that "[t]o commence the national stage, 35 U.S.C. 371(c)(2) says that a copy of the international application ought to be filed 'unless . . . already communicated by the International Bureau'."

Between 14 September 1998 and 21 September 1998, applicants received a Filing Receipt (Form PTO-103X) mailed by the PTO indicating the filing date of the above-mentioned application as 31 October 1997 and indicating that the application is a continuation of PCT/US97/05320 filed 01 April 1997.

On 21 September 1998, applicants filed a WITHDRAWAL OF PETITION RELATING TO FILING DATE (PETITION DATED SEPTEMBER 9, 1998) requesting withdrawal of the previously filed petition and a refund of the petition fee. The petition states that the Filing Receipt indicates a filing date of 31 October 1997 which is the date applicants petitioned for. This WITHDRAWAL was accompanied by a copy of the Filing Receipt.

On 04 June 1999, applicants filed a STATUS INQUIRY and a REQUEST FOR REFUND OF PETITION FEE.

On 30 March 2000, the USPTO mailed a decision (1) dismissing applicants' petition under 37 CFR 1.181 filed 14 September 1998, (2) dismissing applicants' request filed 21 September 1998 to withdraw the petition under 37 CFR 1.181, (3) dismissing applicants' request for refund filed 21 September 1998, and (4) vacating the filing receipt received by applicants between 14 September 1998 and 21 September 1998. The decision also indicated that the above-identified application would be treated under 35 U.S.C. 111 and be accorded a filing date of 14 September 1998.

On 10 May 2000, applicants submitted a RENEWED PETITION UNDER 37 CFR 1.181 requesting reconsideration of the decision mailed 31 August 2000. Specifically, applicants requested that the application be accorded a filing date under 35 U.S.C. 111 of 31 October 1997 and that the declaration filed 31 October 1997 be accepted. Alternatively, applicants argued that the application was properly filed under 35 U.S.C. 371 on 31 October 1997.

On 01 November 2000, the USPTO mailed a decision dismissing applicants' renewed petition under 37 CFR 1.181. The decision also noted that applicants could file a petition under 37 CFR 1.137 to revive the international application as being unintentionally abandoned in order to establish copendency. It was further noted that if this course of action were taken, applicants could either claim 35 U.S.C. 120 benefit in the above-identified application to the PCT application or could instead file another application under 35 U.S.C. 371.

On 04 January 2001, applicants submitted the instant "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" along with a preliminary amendment which amends the specification to include a specific reference claiming benefit under 35 U.S.C. 120 to the international application.

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), the filing of the present continuing application under 35 U.S.C. 111(a) on 14 September 1998 is accepted as an appropriate response under 37 CFR 1.137(b).

As to item (2), the requisite petition fee of \$620.00 was submitted on 04 January 2001.

With regard to item (3), petitioner's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137 was unintentional" satisfies this requirement.

CONCLUSION

The petition under 37 CFR 1.137(b) to revive international application PCT/US97/05320 is hereby **GRANTED** as to the National stage in the United States of America for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the present continuing application number 08/962,077.

This application is being forwarded to the Office of Initial Patent Examination for processing as a regular national application under 35 U.S.C. 111(a) and for issuance of a new Filing Receipt with a filing date of **14 September 1998** and indicating that the present application is a continuation of PCT/US97/05320, filed 01 April 1997.



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